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08/910,980	08-07-1997	THOMAS D. PETITE	81607-1012	3165

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DANIEL R. MCCLURE
THOMAS KAYDEN HORSTEMEYER & RISLEY
100 GALLERIA PARKWAY N.W.
#1500
ATLANTA, GA 303395948

EXAMINER

KIM, AHSHIK

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 07-21-2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	08/910,980	PETITE, THOMAS D.
	Examiner Ahshik Kim	Art Unit 2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 07/02/03 (Response).

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 17-36 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 17-36 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Receipt of Response

1. Receipt is acknowledged of the response filed on July 2, 2003. Claims 17-36 remain for examination.
- 5

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

- 10 A person shall be entitled to a patent unless –
 - (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
2. Claims 17-27 and 30-36 are rejected under 35 U.S.C. 102(b) as being anticipated by
- 15 Parienti (US 5,189,287).

Re claims 17, 20, 23, 26, 27, 30, 32, and 34-36, Parienti teaches a system for transmitting billing information (col. 3, lines 49+) comprising a portable remote access unit 1 which communicates with a terminal 11 via infrared (col. 3, lines 12+). As further described (see abstract; col. 2, lines 18+), the portable unit contains memory area to retain permanent data relating to the user. The unit further contains an alphanumeric keyboard 4, and a display screen (col. 2, lines 35+) will guide them for various transactions. Although Parienti does not explicitly suggest of a transmit button, the unit 1 is capable of transmitting and receiving the data from the host or exchange data with other portable units (col. 4, lines 1-30). In triggering such transmittal and/or receipt of data, the device should have a key (may be a hard key or soft key) to initiate

data transmission. The portable unit, the host, and other component parts of the system are equipped with necessary software to execute assigned tasks. For example, the device should contain card-reading software, infrared transmission software, keyboard software, etc.

Re claims 18 and 19, in the embodiment wherein the unit is used as a payment terminal
5 (see figure 5, col. 3, lines 49+), the unit contains an identification data, which may be a bank account number, credit card number or long distance billing account number.

Re claims 22 and 33, although Parienti is silent on formatting data or structure of the data packet, in order to initiate and fulfill payment or other type of transaction, it is inherent that data being transmitted contains all necessary parts (i.e., identification information, transactional
10 information, payment information, etc.) for the financial institutions to approve/disapprove transactions.

Re claim 24, the communication between a portable terminal and the host can be achieved utilizing a telephone line (see abstract; col. 1, lines 16+).

Re claim 25, as illustrated in figure 6A and 6B, one can reasonably suggest that the
15 distance between the terminal 11 and the portable unit 1 is within several feet.

Re claim 31, as shown in figure 5, a bank card (magnetic card) 15 can be used with the portable unit.

Claim Rejections - 35 USC § 103

20 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parienti
5 (US 5,189,287) in view of Tait et al. (US 5,550,358). The teachings of Parienti have been
discussed above.

Although a conventional credit card transaction and bank card transaction disclosed in Parienti (col. 3, lines 49+) require the users to enter a PIN number, Parienti fails to specifically teach or fairly suggest of authorizing use of the communication device.

10 Tait teaches a remote wireless transaction system (see abstract), which allows transaction to proceed (and in turn the use of the device) only after user-provided PIN number is verified (see abstract; col. 2, lines 17). Tait also teaches wireless communication utilizes radio frequency signal (col. 3, lines 30+) as recited in claim 29.

In view of Tait's teaching, it would have been obvious to an ordinary skill in the art at the
15 time the invention was made to employ notoriously old and well-known PIN number or other means of user verification (i.e., password, biometric verification) to the teachings of Parienti in order to ensure that user-sensitive information can only be used after verifying authenticity of the user. Such layer of protection or user authentication is well known in the art, and widely used in various embodiments. Since the transaction can proceed only after successful verification, use of
20 the transaction device is not permitted if such authentication process fails. As further suggested by Tait, use of infrared or radio frequency can be considered functionally equivalent to one ordinary skill in the art.

Response to Arguments

4. Applicant's response filed on July 2, 2003 have been carefully studied and considered, but they are not persuasive.

Applicant argues that the terminal 11 shown in Parienti is not a communication device (see page 4, second paragraph). Parienti, as many figures illustrate, disclose a communication 5 system comprising a portable unit 1, a terminal 11, and a central computer, all of which communicate among each other to achieve desired functions (col. 3, lines 29+). Therefore, each component of the system (i.e., portable unit, terminal and central computer) is a communication device.

Applicant also points out acoustic communication disclosed in one embodiment of 10 Parienti (see page 4, third paragraph). Examiner reminds Applicant that "acoustic" method is not the only communication means taught in Parienti. Parienti teaches infrared communication, a conventional communication over telephone network (see abstract; col. 1, lines 56-59).

In responding to Applicant's argument that "user identification data" are not one of 15 "banking and/or credit card", "checking account", "calling card number and any other appropriate data", or "calling card/billing info" (see page 5, second paragraph thereafter), Examiner directs Applicant to Parienti (see figure 5; col. 3, lines 50+), wherein the card 15 can be a credit card or bank card.

Although Parienti may not explicitly show "a manually operated transmit button", it is 20 Examiner's view that such function exists, since a user is allowed to enter information using keyboard 4 (col. 2, lines 35+). Since a user is allowed to enter "meaningful information", communication between the portable unit and the terminal is not occurring constantly, meaning

that user must be able to enter the information and then transmit it. Such feature – transmit button is also disclosed in the secondary reference to Tait et al. (item 16; col. 4, lines 55+).

Applicant's remarks and bases for arguments have been given a careful consideration.

Previously presented claims have been reviewed again in view of the remarks submitted.

5 However, it is Examiner's position that Parienti or Parienti in view of Tait teach the subject matter presented in the claims, and therefore, Examiner has made this Office Action final.

Conclusion

10 **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after 15 the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

5 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.

10 Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

15 *All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

20 Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

20

Ahshik Kim
Patent Examiner
25 Art Unit 2876
July 16, 2003


MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800